

Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 09/885,395

Confirmation No.: 3952

Filed: 20 June 2001

For: LABEL FOR AFFIXING TO A GARMENT

Remarks

The Office Action mailed 1 November 2004 has been received and reviewed. No claims having been amended, added, or canceled, the pending claims are claims 19-30. Reconsideration and withdrawal of the rejections are respectfully requested.

The 35 U.S.C. §103(a) Rejection

The Examiner rejected claims 19, 20, 22, and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Stahl (U.S. Patent No. 6,194,044) in view of Silver et al. (U.S. Patent No. 5,118,750). Applicants respectfully traverse this rejection.

"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. §2143. Applicants respectfully traverse the rejection.

The present claims recite "a second adhesive layer other than a hot melt adhesive layer, comprising an elastomeric microsphere adhesive" (e.g., present application, claims 19 and 26). Applicants respectfully submit that there is no suggestion or motivation, either in documents or in the knowledge generally available to one of ordinary skill in the art, to modify the documents, as discussed in the Amendment and Response submitted August 13, 2004, the discussion of which is incorporated herein by reference.

In brief, Stahl discloses the use of "a thermoplastic adhesive 14 coating one face of the fabric layer 12; a pressure-sensitive adhesive 16 coating the thermoplastic adhesive 14" (e.g., column 3, lines 1-3). However, this passage is silent regarding whether the second layer is also a hot melt adhesive.

However, the Examiner asserted that "Stahl's silence with regards to the PSA being a hot melt adhesive is an implicit disclosure of the PSA NOT being a hot melt adhesive. The burden is upon the applicant to prove otherwise" (e.g., page 5, lines 19-21, Office Action

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mailed 1 November 2004). Applicants earnestly disagree.

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." M.P.E.P. §2142. Furthermore, in evaluating lack of disclosure regarding an obviousness rejection, the Court of Customs and Patent Appeals has stated that "[s]ilence in a reference is hardly a proper substitute for an adequate disclosure of facts from which a conclusion of obviousness may justifiably follow." (*See In re Burt and Walter*, 148 U.S.P.Q. 548, 553 (C.C.P.A. 1966)). Applicants respectfully submit that Stahl's silence regarding a second layer other than a hot melt adhesive is not a "proper substitute for an adequate disclosure of facts" required to support a conclusion of obviousness.

Further, Stahl describes the "outer adhesive being a pressure and *heat* sensitive adhesive" (e.g., column 4, lines 60-61 and column 5, lines 13-14, emphasis added). Moreover, Applicants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (M.P.E.P. §2141.02). Applicants respectfully submit that Stahl's characterization of the outer adhesive being a pressure and *heat* sensitive adhesive leads away from the claimed invention (e.g., a second adhesive layer *other than a hot melt adhesive layer*, as recited in claims 19 and 26).

Although, the Examiner asserted that "the mere fact that an adhesive substrate is heat sensitive does not necessarily mean that the adhesive is a hot melt adhesive" (e.g., page 6, line 2-3, Office Action mailed 1 November 2004), Applicants respectfully submit that they do not have a burden of showing what necessarily follows from the disclosure of Stahl. In contrast, if the Examiner is basing the rejection on inherent properties of the second adhesive layer disclosed by Stahl, it is the Examiner's burden to show that the inherent properties necessarily follow, as recited, for example, in the M.P.E.P.:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact

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that a certain thing may result from a given set of circumstances is not sufficient.'"

Applicants respectfully submit that the Examiner has not met that burden.

As such, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 19, 20, 22, and 24-25 under 35 U.S.C. §103(a).

Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 21, 23, and 26-30 under 35 U.S.C. §103(a) as being unpatentable over Stahl (U.S. Patent No. 6,194,044) in view of Silver et al. (U.S. Patent No. 5,118,750), and further in view of Bingham (U.S. Patent No. 3,758,192). Applicants respectfully traverse this rejection.

Applicants respectfully submit that there is no suggestion or motivation, either in documents or in the knowledge generally available to one of ordinary skill in the art, to modify the documents.

Bingham discloses "colored reflex-reflecting structures, particularly reflex-reflecting signs, fabrics and transfer films, in which a monolayer of small transparent glass beads or microspheres is embedded in a binder layer having a reflective nacreous pigment embedded therein" (e.g., column 1, lines 7-12). Based upon the remarks herein above, Applicants respectfully submits that Bingham fails to correct the deficiencies of Stahl in view of Silver et al. noted herein above.

As such, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 21, 23, and 26-30 under 35 U.S.C. §103. Applicants respectfully request reconsideration and withdrawal of the rejection.

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It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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January 25, 2005

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to **Mail Stop AF**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 25th day of January, 2005, at 10:08 a.m. (Central Time).

By: Name: Rachel Englioni-Gibson